

**REMARKS/ARGUMENTS**

Claims 1, 2, 4-13, 15-16 and 18-37 are pending in the application. Claims 3, 14 and 17 have been previously cancelled without prejudice. Claims 36 and 37 are new.

**Status of Related Applications**

The following U.S., foreign, and international patent applications are or may be considered to be related to the application herein. Relevant documents pertaining to such cases are or have been provided in one or more separately-filed Information Disclosure Statements. The status of such applications is summarized in order to ensure that the Office is fully apprised of the current state thereof. In the event the Office has any questions about the identified cases, the Examiner is requested to call the Applicant's representative at the number below.

Serial No.	Country	Status
2,458,098	Canada	Pending

**Claim Amendments**

Claims 1, 6, 7, 9, 12, 13, 18, 20, 24, 33, 34 and 35 have been amended for clarity.

In particular, amendments to claims 34 and 35 find support throughout the application as filed, for example in paragraph [0064].

New claims 36 and 37 have been added. Support for these claims may be found throughout the application as filed, for example in paragraph [0064].

**Claim Rejections – 35 USC § 103**

Claims 1, 2, 4-13, 15, 16, 18-26 and 29-35 stand rejected under 35 U.S.C. 103(a) having regard to U.S. Patent No. 6,049,796 to Siitonen et al. ("Siitonen") in view of U.S. Patent No. 6,950,988 to Hawkins et al. ("Hawkins"), in view of U.S. Publication No. 2004/0155908 to Wagner ("Wagner"), and further in view of U.S. Patent No. 7,295,852 to Davis et al. ("Davis"). Although not explicitly stated by the Office Action, on page 7, U.S. Patent No. 7,072,461 to Padawer et al. ("Padawer") is also cited against at least claim 1.

For the purposes of this response, claim 1 is representative. Claim 1 recites:

- “at least one component to compose a destination for an outgoing communication generated by one of the at least two communication capabilities of the device”
- “wherein the at least one component to compose the destination is invokable from the main screen via selection of one of the application icons and is also invokable after an alphanumeric input of a portion of the destination is received through the first input device.”

Thus, claim 1 describes a main screen from which at least two different communication capabilities may be invoked. In particular, different composition components for respective different communication capabilities can be invoked from the main screen using **two** different methods: i) by selecting the icon for the respective communication capability; or ii) by inputting an alphanumeric character. The claims describe where **both** options for invoking the composition component are simultaneously available from the main screen.

At least these claim elements are not all found in the cited references.

The dependent claims recite additional elements that are not all found in the cited references, for example:

- in claims 33 and 34: “wherein, after determining that the alphanumeric input is a telephone number, the component to compose a destination is a composition screen for a telephone call, and after determining that the alphanumeric input is a URL address, the component to compose a destination is a web browser”
- in claims 35 and 36: “wherein, after determining that the alphanumeric input is a telephone number, the component to compose a destination is a composition screen for a telephone call, and after determining that the alphanumeric input is an email address, the component to compose a destination is an email message composition screen”

#### **Legal requirements for a finding of obviousness**

In order to reject a claim based on a combination of references, as explained at MPEP 2143 (citing the Supreme Court in *KSR v. Teleflex*), “Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

*KSR*, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

In the present case, the Applicant submits that:

1) The claimed elements are not all found in the cited references. In particular, at least the claimed element "wherein the at least one component to compose the destination is invokable from the main screen via selection of one of the application icons and is also invokable after an alphanumeric input of a portion of the destination is received through the first input device" is not found in the cited references.

2) A person skilled in the art would not have combined the cited references to arrive at the claimed elements.

3) The combination of a large number of references is based on improper hindsight analysis using teachings from the Applicant's disclosure.

4) The dependent claims recite further elements not found in the cited references.

**1) The claimed elements are not all found in the cited references**

The Applicant submits that the cited references do not teach at least the claimed element "wherein the at least one component to compose the destination is invokable from the main screen via selection of one of the application icons and is **also** invokable after an alphanumeric input of a portion of the destination is received through the first input device."

The Office Action, on page 5, concedes that Siitonen, Hawkins and Wagner do not disclose that the component to compose a destination for a respective communication capability is invokable from the main screen via selection of the application icon for the respective communication capability. Davis is relied upon to remedy these deficiencies.

The Applicant submits that claim 1 does not only recite that the component to compose a destination is invokable via selection of an application icon, but that the component to compose a destination is also invokable after an alphanumeric input is received at the main screen. Thus, what is being claimed is not simply that invoking a component to compose a destination is possible by selecting an application icon on a main screen, but that additionally the component to compose a destination can be invoked by entering alphanumeric input. The present claims provide two ways to invoke a component to compose a destination - selection of an application icon or directly entering alphanumeric input.

The Office Action, on page 6, notes that "Davis discloses that the component to compose the destination is invokable from a home screen component via selection of the application icon for the respective communication capability". The Office Action asserts that Davis "provides motivation for Siitonen, Hawkins and Wagner to access their application icons manually to compose a destination" and that a person skilled in the art "would have been motivated to learn from Davis that the component to compose the destination is invokable from the home screen component manually by activating a communication application icon."

However, none of Siitonen, Hawkins, Wagner and Davis teaches or suggests providing, at the same time, two alternatives for invoking the component to compose a destination on the main screen. The Office Action asserts that Davis provides the motivation to invoke the component to compose a destination by activating an application icon and attempts to combine this with the option of invoking the component by key-based input. However, there is no teaching and no reasoning in Davis or any of the other cited references

that there should be two simultaneously available alternatives for invoking the component to compose a destination. The cited references teach only one method or the other. Simply pointing to different methods for invoking the component to compose a destination does not offer any teaching, suggestion or motivation that any two different methods should be available at the same time on the main screen.

Although not cited by the Office Action, further combination with Padawer also would not remedy this deficiency, since Padawer does not teach any application icon and hence allows for only key-based input.

Furthermore, in the present claims, there is provided "at least one component to compose a destination for an outgoing communication generated by a respective one of the at least two communication capabilities". That is, there are different components for composing a destination for respective different communication capabilities. For example, after receiving a numeric input, a component to compose a destination for telephone communication (e.g., dialling a telephone number) might be invoked, while alphabetic input might cause a component to compose a destination for email communication (e.g., entering an email address) to be invoked.

In contrast, in Padawer, there is only one communication capability - telephony. As shown in figures 2A-2F of Padawer, there is only one component to compose a destination that is provided and it is only for voice communications, namely telephony. What is taught by Padawer is that different input methods may be used to dial a number using a single component to compose a destination.

This is different from the present claims, in which "one of...at least two communication capabilities is invocable". This is entirely different from Padawer, which does not provide "one of...at least two communication capabilities". In contrast, Padawer provides "first response data and...second response data to the user so the user may review the first and second response data through a single unified user interface" (see, for example, column 12, lines 58-61). Padawer allows "a user to enter a request such as via dialing input, without requiring that the user commit to a particular dialing method (see, for example, column 12, lines 65-67).

Therefore, Padawer fails to remedy the deficiencies of Siitonen, Hawkins, Wagner and Davis.

In view of the above, the claimed feature "wherein the at least one component to compose a destination for a respective one of the at least two communication capabilities is invokable from the main screen via selection of the application icon for the respective communication capability and is also invokable after an alphanumeric input is received" is not taught or suggested by the cited references. The Applicant respectfully asks that the rejection under 35 U.S.C. 103(a) be withdrawn for at least this reason.

**2) A person skilled in the art would not have combined the cited references to arrive at the claimed elements**

The Applicant submits that, contrary to the assertions of the Office Action, there is no reason for a person skilled in the art to combine Davis with Siitonen, Hawkins, Wagner and Padawer to arrive at the solution where there are two simultaneously available alternatives for invoking the component to compose a destination. Siitonen, Hawkins and Padawer teach entering alphanumeric input to compose a destination. This is sufficient to compose a destination. There is no reason for a person skilled in the art to turn to any other method, such as selection of an application icon, to invoke a component to compose a destination.

Indeed, as the Office Action notes on page 4, one purpose of Hawkins is to provide a more direct and efficient means for invoking a component to compose a destination, since it may be difficult for a user to concentrate on the task of retrieving a directory record or making a mode selection (see, for example, column 3, lines 1-12 of Hawkins). Adding the selection of an application icon to invoke a component to compose a destination, as suggested by the Office Action based on the teachings of Davis, would be contrary to the stated purpose of Hawkins and would negate the intention of Hawkins.

Adding the selection of application icons to a user interface that is not designed to accommodate icons, such as the interfaces shown in Siitonen, Hawkins and Padawer, is not a simple task and in fact would be counterintuitive to a person skilled in the art. Such a modification would result in increased visual clutter and increased complexity in the user interface, and such an impact would be amplified by the limited screen size of a wireless device. By providing an interface that is responsive to two different types of potential inputs (namely, selection of an application icon and key-based alphanumeric input), the wireless device must be programmed to have more complex decision-making and thus increases the burden on the already limited processing and memory resources of a wireless device. Thus, the modification proposed by the Office Action would be counterintuitive to a person skilled in the art.

Since Siitonen, Hawkins and Padawer already teach a viable method to invoke a component to compose a destination, namely by key-based input, and indeed are designed around key-based input, there is no reason for a person skilled in the art to turn to the selection of application icons to invoke a component to compose a destination.

In view of the foregoing, the Applicant submits that a person skilled in the art would not have combined the cited references in the manner suggested by the Office Action to arrive at the claimed elements. Thus, the rejection under 35 U.S.C. 103(a) is improper for at least this reason.

**3) The combination of a large number of references is based on improper hindsight analysis using teachings from the Applicant's disclosure**

The Applicant notes that no fewer than five references have been combined in the 35 U.S.C. 103(a) rejection against the independent claims.

The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil* (1985), the Federal Circuit noted that "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." In *In re Fritch* (1992), the Federal Circuit noted:

"[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

"In *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987), the court held that a combination of about twenty references that 'skirt[ed] all around' the claimed invention did not show obviousness. In other instances, on other facts, we have upheld reliance on a large number of references to show obviousness."

It was also noted in *ATD Corp. v. Lydall, Inc.*, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998): "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented

invention" and in *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902 , 907 , 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'"

In the present case, in this eighth Office Action, no less than five separate references are relied upon to arrive at the present claims. Each of the cited references is deficient in teaching the elements of the present claims in some way. Each of the cited references teaches a different way of composing a communication destination or invoking an application. Considering that each reference provides a different solution, there is no reason for a person skilled in the art to continue searching and combining references in the manner suggested in the Office Action, unless motivated by improper hindsight analysis based on the teachings and claims of the present application. Further, as explained above, it would be counterintuitive to a person skilled in the art to modify the cited references in the manner suggested, in view of the limitations of a wireless device and the increased complexity required for such modifications.

Therefore, the Applicant submits that the combination of Siltonen, Hawkins, Wagner, Davis and Padawer is based on improper hindsight analysis and is improper for a rejection under 35 U.S.C. 103(a). The Applicant respectfully asks that the rejection be withdrawn for at least this reason.

#### **4) The dependent claims recite further elements not found in the cited references**

The Applicant submits that the present claims are all patentable over the cited references for at least the above reasons. In addition, the dependent claims recite further elements not found in the cited references and are therefore patentable for at least this additional reason.

Claims 33 and 34 recite: "wherein, after determining that the alphanumeric input is a telephone number, the component to compose a destination is a composition screen for a telephone call, and after determining that the alphanumeric input is a URL address, the component to compose a destination is a web browser."

Similarly, claims 35 and 36 recite: "wherein, after determining that the alphanumeric input is a telephone number, the component to compose a destination is a composition



screen for a **telephone call**, and after determining that the alphanumeric input is an email address, the component to compose a destination is an email message composition screen."

On page 22 of the Office Action, it is conceded that the previously-submitted arguments in support of claim 33 do indicate valid points, however there is a lack of clarity in the claim language. The Applicant thanks the Examiner for this guidance. It is believed that claims 33-36 clarify the language of the claims and clearly recite subject matter that is patentable over the cited references.

### Summary

In view of the foregoing, the Applicant submits that the present claims are all patentable over Siitonen, Hawkins, Wagner, Davis and Padawer for at least the following reasons:

1) The claimed elements are not all found in the cited references. In particular, at least the claimed element "wherein the at least one component to compose the destination is invokable from the main screen via selection of one of the application icons and is also invokable after an alphanumeric input of a portion of the destination is received through the first input device" is not found in the cited references.

2) A person skilled in the art would not have combined the cited references to arrive at the claimed elements.

3) The combination of a large number of references is based on improper hindsight analysis using teachings from the Applicant's disclosure.

4) The dependent claims recite further elements not found in the cited references.

The Examiner is respectfully asked to withdraw the rejection under 35 U.S.C. 103(a).

### Conclusion

The Applicant believes that it has responded to each ground of rejection raised by the Examiner, and that for at least the reasons cited above the claims, as presented, are in condition for immediate allowance. The Applicant respectfully requests reconsideration and allowance of the claims.

The Applicant is concerned to advance this application as quickly as is reasonably possible. Accordingly, the Applicant respectfully requests that, in the event the Examiner has any further questions about this application, the Examiner call the Applicant's attorney at the number provided below.

The Applicant believes that no further fees are due in connection with the filing of this paper. In the event that the office determines that any further fee is due, the Applicant requests that such fee be charged to its Deposit Account No. 195113.

The Applicant requests that any questions concerning this matter be directed to the undersigned.

Respectfully submitted,

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